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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/516,908	03/01/2000	Shmuel Shaffer	00P7493US	3123

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Siemens Corporation  
Intellectual Property Department  
186 Wood Avenue South  
Iselin, NJ 08830

EXAMINER
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HU, JINSONG

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/516,908

Applicant(s)

SHAFFER ET AL.

Examiner

Jinsong Hu

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

1. Claims 1-35 are presented for examination. Claims 1, 8 and 17 have been amended; Claims 21-35 are newly added claims.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3-4, 8-11 and 28-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Mogul et al. (US 6,243,761 B1).

4. As per claims 1 and 32-35, Mogul teaches the invention substantially as claimed including a method for providing data files to a remote user over a channel [col. 1, lines 9-13] comprising:

determining the speed of a channel, estimating the transfer time for a data file [col. 4, lines 28-30; col. 9, lines 48-54]; and based on a parameter [i.e., network address] set by the remote user [col. 4, lines 34-39] responsive to said transfer time,

determining either to transfer said data file or a compressed version of the data file [col. 5, lines 50-57; col. 7, line 66 – col. 8, line 4]; and transferring said data file or a compressed version of said data file based on determining [col. 5, lines 58-67; col. 7, lines 44-58; col. 9, lines 54-56].

5. As per claim 3, Mogul teaches the step of determining the speed of a channel when received user's downloading requesting [col. 4, lines 15-23].

6. As per claims 4 and 31, Mogul teaches that the data files include at least one file of at least one file type from the group consisting of digitally encoded audio files, digitally encoded video files, digitally encoded text, and digitally encoded images [col. 4, lines 7-8; col. 5, lines 8-11].

7. As per claims 8 and 28-29, Mogul teaches the invention substantially as claimed including a method for providing data file to as remote user over a channel comprising:

determining the speed of a channel, using the speed, estimating the transfer time for a data file [col. 4, lines 28-30];

responsive to said transfer time, determining whether to transfer said data file or a compressed version of the data file [col. 5, lines 50-57; col. 7, line 66 – col. 8, line 4];

transferring said data file or a compressed version of said data file based on determining [col. 5, lines 58-67];

the method further comprising:

transmitting to a user system data representing a list indicating available data files, indicating estimated transfer times for said data files [203, Fig. 2] and for compressed versions of a data file [i.e., no more than sixty seconds], and receiving a user selection of a data file indicating a desired transfer delay [col. 5, lines 57-67; col. 7, lines 53-58].

8. As per claims 9-11 and 30, Mogul teaches the step of comparing the transferring time with a threshold and converting a file to another format if the transferring time exceeds a threshold [col. 7, lines 53-58; col. 9, lines 34-44; col. 10, lines 23-27].

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mogul et al. (US 6,243,761 B1) applied to claims 1, 3-4, 8-11 and 28-35 above, in view of Barrett et al. (US 5,908,467).

11. As per claims 2 and 5, Mogul teaches the invention substantially as claimed in claim 1. Additionally, Mogul teaches the step of determining the speed of the channel

Art Unit: 2154

[col. 6, line 49 – col. 7, line 6; col. 8, lines 63-67]. Mogul does not specifically teach the step of sending a test on the channel.

12. Barrett on the other hand teaches the step of sending a test on the channel [22, Fig. 3; col. 4, lines 5-12]. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Mogul and Barrett because doing so would improve the management of the system by obtaining more accurate transfer speed which used as the criteria of compression. One of ordinary skill in the art would have been motivated to modify Mogul with Barrett's test step to improve the performance of the system.

13. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mogul et al. (US 6,243,761 B1) applied to claims 1, 3-4, 8-11 and 28-35 above, in view of Bentley et al. "The freedom to choose: Transforming content on-demand in the BSCW shared Workspace system (hereinafter as BSCW)", Germany Research center for computer science, 1997.

14. BSCW is a prior art reference cited by the Applicant on 1449, file on 8/30/00.

15. As per claims 6-7, Mogul teaches the invention substantially as claimed in claim 1. Mogul does not specifically teach the step of receiving an indication from a user as to

Art Unit: 2154

what compression format are decodable by the use system and sending the relevant applet to user for accessing the compressed file.

16. However, BSCW on the other hand teaches the step of receiving an indication from a user as to what compression format are decodable by the user system and sending the relevant applet to user for accessing the compressed file [p. 5, second paragraph; p. 6, first paragraph]. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to including BSCW's format selecting step in Mogul's system because doing so would improve the dynamic of the system by allowing the clients selecting the formats they prefer. One of ordinary skill in the art would have been motivated to modify Mogul's system with BSCW's selecting step to benefit users.

17. Claims 12-19 and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrett et al. (US 5,908,467) in view of Bentley et al. "The freedom to choose: Transforming content on-demand in the BSCW shared Workspace system (hereinafter as BSCW)", Germany Research center for computer science, 1997.

18. As per claims 12, 15-16, 22-25 and 27, Barrett teaches the invention substantially as claimed including a method for providing remotely accessible multimedia messages [col. 2, lines 15-25] comprising:

determining the speed of a channel, determining the transfer time for available messages and attachments using the size of available messages and attachments and said speed providing data representing a list of available messages to a user [col. 3, line 61 – col. 4, line 12; col. 5, line 64 – col. 6, line 2; col. 6, lines 10-15].

19. Barrett does not specifically teach the steps of providing format option to user and receiving data from the user for indicating a desired compression option.

20. However, BSCW on the other hand teaches the steps of providing format option to user and receiving data from the user for indicating a desired compression option [p. 5, second paragraph]. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Barrett and BSCW because adding BSCW's format selecting step in Barrett's would improve the dynamic of Barrett's system by allowing the clients selecting the formats they prefer. One of ordinary skill in the art would have been motivated to modify Barrett's system with BSCW's selecting step to attract more users.

21. As per claim 13, Barrett teaches the step of sending a test on said channel and detecting the transfer time of said test on said channel [col. 4, lines 5-12].

22. As per claims 14 and 26, Barrett teaches that the data files include at least one file of at least one file type from the group consisting of digitally encoded voice



Art Unit: 2154

messages, digitally encoded email messages, digitally encoded video messages, and digitally encoded facsimiles [col. 1, lines 39-40; col. 3, line 21].

23. As per claims 17-19, since they are apparatus claims of claims 12-13 and 15, they are rejected for the same basis as claims 12-13 and 15 above.

24. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrett et al. (US 5,908,467).

25. As per claims 20 and 21, Barrett teaches the invention substantially as claimed including a method for presenting to a user a list of messages for interacting with a multimedia message server comprising:

presenting to a user an identification of a message available for transfer, presenting an indication of a transfer time indicating time for transferring of a message [col. 3, line 61 – col. 4, line 12; col. 5, line 64 – col. 6, line 2].

26. Barrett does not specifically teach presenting a transfer time for a compressed message to user and registering the user action indicating a compression option to be transferred. However, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to present transfer time for compressed version and registering the user action in Barrett's system because doing so will bring convenience to users by allowing them make a selection based on their need [col. 8, lines 56 – col. 9,

line 6]. One of ordinary skill in the art would have been motivated to modify Barrett's system for attracting more users.

### ***Conclusion***

27. Applicant's arguments filed on 1/2/04 for claims 1-35 have been fully considered but they are not deemed to be persuasive.

28. In the remarks, applicant argued in substance that (1) Mogul does not teach the step of indicating estimated transfer times for compressed versions of a data file; (2) Mogul does not teach the version determining is also based on a parameter set by the remote user; (3) Barrett does not teach determining the transfer time based on the message's size and transferring speed; (4) Barrett does not teach registering the user action indicating a compression option to be transferred; (5) None of the references teaches sending a test is initiated in response to a user login; (6) BSCW does not teach sending the relevant applet to user for accessing the compressed file.

29. Examiner respectfully traverses applicant's remarks:

A. As to point (1), applicant fails to consider the teaching of the Mogul's reference for the default values which being used for file compression [col. 7, lines 53-58], those default values such as no more than sixty seconds are estimated transmitting times for compressed versions of a data file. Thus, Mogul does teach the step of indicating estimated transfer times for compressed versions of a data file.

Art Unit: 2154

B. As to points (2) and (4), see corresponding paragraphs in this action for details.

C. As to points (3) and (5), applicant fails to consider the teaching of the Barrett's reference for sending a test message and estimating the length of a full download for a file would require [col. 4, lines 5-12], if Barrett doesn't consider the message's size as applicant argued, the estimated download time for different size [i.e., big or small] messages in the same channel should be exactly the same length. It is implacable for both logical and practical reasons. Thus, Barrett does teach sending a test is initiated in response to a user login and determining the transfer time based on the message's size and transmitting speed.

D. As to point (6), applicant fails to consider the teaching of the BSCW's reference for invoking the corresponding transformation tool and adding resulting document to the user's private Bag [Fig. 4; p. 6, first paragraph]. BSCW does teach sending the relevant applet to user for accessing the compressed file.

Accordingly, Mogul, Barrett and BSCW are relevant prior art references.

30. THIS ACTION IS MADE FINAL. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

31. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory

period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinsong Hu whose telephone number is (703) 306 – 5932.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee, can be reached on (703) 305-8498. The fax number for this Group 2100 is (703) 872-9306.

Any inquiry of a general nature or relating to the status of the application should be directed to the Group receptionist at (703) 305-3900.

Jinsong Hu

March 16, 2004

  
ZARNI MAUNG  
PRIMARY EXAMINER